



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/283,938	04/01/1999	HIDEKAZU TANIGAWA	NAKI-AZ70A	1666

7590

06/18/2002

PRICE GESS & UBELL
2100 S E MAIN STREET
SUITE 250
IRVINE, CA 92715

EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 06/18/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/283,938

Applicant(s)

TANIGAWA ET AL.

Examiner

Son P Huynh

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 93-130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 93-130 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 93-99, 108-120, 123-130 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear which figure the "supplementary design storing means" reads on.

Regarding claim 94, the phrase "identification member" does not disclose in the specification. Examiner interprets this as 'identification number'.

Regarding claim 99, "storing rim supplementary designs" (page 8, line 14) is unclear.

Regarding claim 119, the claim language is unclear. The limitations of the receiving apparatus are repeated.

Regarding claim 123, "gal image signal" (page 22, line 15) is unclear.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 93-130 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 12, 17, 18, 23 and 27 Patent No. 5,973,681.

Regarding claim 93, the claim limitations correspond to claim 18 of patent No. 5,973,681. Claim 93 requires a transmitting apparatus comprises a transmitting means to repeatedly transmit the multiplexed signal specified therein. Patent claim 18 recites the functionality of the multiplexed signal being transmitted, but not any structure to accomplish this. Inherently, the system comprising a transmitting apparatus, which has a transmitting, means for transmitting the multiplexed signal as specified in claim 18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 18 of '681' to include position information of the background

Art Unit: 2611

image in the multiplexed signal in order to have a background image display in a predetermined position. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a storing means at the transmitting apparatus in order to store the background image, position information and other data.

Regarding claim 96, the claim limitations are rejected as discussed in the rejection of claim 93. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 18 of '681' to utilize at least a cursor image in the supplementary designs in order to indicate the movement of input device on graphical user interface.

Regarding claim 97, the claim limitations correspond to claim 3 of patent 5,973,681. However, claim 3 of '681' does not explicitly recite the supplementary design combining information includes a position information indicating the position in a background image; a supplementary design means for storing supplementary designs; and supplementary design reading means for reading a supplementary design from the supplementary design storing means. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 3 of '681' to include the position information in the supplementary design combining information in order to have the background image displays on a predetermined position. It also would have

Art Unit: 2611

been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 3 of '681' to utilize supplementary design storing means in the receiving apparatus for storing supplementary designs in order to reduce the amount of supplementary designs transmitted to the receiving apparatus. Furthermore, it also would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 3 of '681' to utilize supplementary design reading means in the receiving apparatus for reading supplementary design from the supplementary design storing means in order to provide accurate supplementary design.

Regarding claim 98, the claim limitations are rejected as discussed in the rejection of claim 97. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 3 of '681' to utilize at least a cursor image in the supplementary designs in order to indicate the movement of input device on graphical user interface.

Regarding claim 99, the claim limitations are rejected as discussed in the rejection of claim 98. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 3 of '681' to utilize two types of cursor images in the supplementary designs that respectively represent a selected and a none-selected state in order to prevent the user from selecting the same graphical image numerous times.

Regarding claim 100, the claim limitations correspond claim 12 of '681' except the supplementary design being stored by the receiving apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 12 of '681' to store the supplementary design at the receiving apparatus in order to reduce the amount of data transmitted to the receiving apparatus.

Regarding claim 107, the claim limitations correspond to claim 17 of '681'. Claim 107 is broader in scope than patent claim 17.

Regarding claim 108, the claim limitations correspond to claim 18 of '681' except including position information of the background image in the multiplexed signal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 18 of '681' to include position information of the background image in the multiplexed signal in order to have a background image display in a predetermined position.

Regarding claim 115, the claim limitations are rejected as discussed in the rejection of claim 108. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 18 of '681' to utilize at least a cursor image in the supplementary designs in order to indicate the movement of the input device on a graphical user interface.

Regarding claim 118, the claim limitations correspond to claim 23 of '681'. However, claim 23 of '681' does not explicitly recite the supplementary design combining information includes a position information indicating the position in a background image; a supplementary design means for storing supplementary designs; and supplementary design reading means for reading a supplementary design from the supplementary design storing means. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 23 of '681' to include the position information in the supplementary design combining information in order to have the background image displays on a predetermined position. It also would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 23 of '681' to utilize supplementary design storing means in the receiving apparatus for storing supplementary designs in order to reduce the amount of supplementary designs transmitted to the receiving apparatus. Furthermore, it also would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 23 of '681' to utilize supplementary design reading means in the receiving apparatus for reading supplementary design from the supplementary design storing means in order to provide accurate supplementary design.

Regarding claim 119, the claim limitations are rejected as discussed in the rejection of claim 118. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 23 of '681' to utilize at least a

cursor image in the supplementary designs in order to indicate the movement of the input device on a graphical user interface.

Regarding claim 120, the claim limitations are rejected as discussed in the rejection of claim 119. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 23 of '681' to utilize two types of cursor images in the supplementary designs that respectively represent a selected and a none-selected state in order to prevent the user from selecting the same graphical image numerous times.

Regarding claim 121, the claim limitations correspond to claim 27 of '681'. It would have been obvious to one of ordinary skill at the time the invention was made to modify claim 27 of '861' to include position information that indicates a position within the background image in order to display the background image at a predetermined position on the screen.

Regarding claim 122, the claim limitations correspond to claim 27 of '681'. It would have been obvious to one of ordinary skill at the time the invention was made to modify claim 27 of '861' to include position information that indicates a position within the background image in order to display the background image at a predetermined position on the screen.

Regarding claim 123, the claim limitations of the method being claimed correspond to the limitations of the system being claim in claim 108 and are analyzed as discussed in the rejection of claim 108.

Regarding claim 124, the claim limitations of the method being claimed correspond to the limitations of the system being claim in claim 108 and are analyzed as discussed in the rejection of claim 108.

Regarding claim 125, the claim limitations of the method being claimed correspond to the limitations of the system being claim in claim 118 and are analyzed as discussed in the rejection of claim 118.

Regarding claim 126, the claim limitation is directed toward embody the system of claim 108 in a "readable recording medium". It would have been obvious to one of ordinary skill in the art at the time the invention was made to embody the procedure of claim 18 of '681' as discussed with respect to claim 108 in a "readable recording medium" in order that the instruction could be automatically performed by a processor.

Regarding claim 127, the claim limitation is directed toward embody the system of claim 115 in a "readable recording medium". It would have been obvious to one of ordinary skill in the art at the time the invention was made to embody the procedure of

Art Unit: 2611

claim 18 of '681' as discussed with respect to claim 115 in a "readable recording medium" in order that the instruction could be automatically performed by a processor.

Regarding claim 128, the claim limitation is directed toward embody the system of claim 118 in a "readable recording medium". It would have been obvious to one of ordinary skill in the art at the time the invention was made to embody the procedure of claim 23 of '681' as discussed with respect to claim 118 in a "readable recording medium" in order that the instruction could be automatically performed by a processor.

Regarding claim 129, the claim limitation is directed toward embody the system of claim 118 in a "readable recording medium". It would have been obvious to one of ordinary skill in the art at the time the invention was made to embody the procedure of claim 23 of '681' as discussed with respect to claim 118 in a "readable recording medium" in order that the instruction could be automatically performed by a processor.

Regarding claim 130, the claim limitation is directed toward embody the system of claim 108 in a "readable recording medium". It would have been obvious to one of ordinary skill in the art at the time the invention was made to embody the procedure of claim 18 of '681' as discussed with respect to claim 108 in a "readable recording medium" in order that the instruction could be automatically performed by a processor.

4. Allowance of claims 93-130 would result in an un-warranted time wise extension of the monopoly granted for the invention as defined in claims 3, 12, 17, 18, 23 and 27 of patent 5,973,681. Therefore, the double patenting rejection is justified.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tanigawa et al. (US 5,648,813) discloses graphical interactive screen display apparatus and peripheral units.

Cobbley et al. (US 5,818,510) discloses method and apparatus for providing broadcast information with indexing.

Klappert et al. (US 6,256,785) discloses method and system for providing interactive look and feel in a digital broadcast via an X-Y protocol.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-0377.

Son P. Huynh
June 14, 2002


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600